

REMARKS

The application has been amended and is believed to be in condition for allowance.

There are no formal matters pending.

Amendments to the Claims

Claims 1-28 are canceled without prejudice.

Claims 29-52 are introduced to replace original claims 1-28, claims 29-52 being based on the subject matter of claims 1-28 and including revisions with respect to style and form in consideration of U.S. practice and preferences. The new claims 29-52 are directed to the elected Group I drawn to a method of payment identified with the requirement for restriction of August 26, 2008.

The new claims also include revisions to clarify the recited features of the invention. For example, new independent claim 29 includes the features of original claims 1, 3, 5, 6, and 12, including revisions to clarify and point out the distinguishing features of the invention. New claim 29 also recites the radiotelephony message as "one radiotelephony message" to clarify that the data is transmitted as a single message transmission, consistent with the description as originally filed (e.g., page 9, lines 1-9).

New independent claims 29 and 51 find further support in the specification and the drawing figures as originally filed (e.g., page 9, lines 3-4 and line 31 to page 10 line 4; page 10

lines 5-7 and lines 14-16; page 11, lines 13-16; page 13, lines 16-19; page 14, lines 4-7 and 12-20; page 17 line 32 to page 18 line 4).

The new dependent claims are also based on the original claims and the specification originally filed. For example, new claims 30-31 correspond to original claims 2 and 3, respectively, and new claims 32-36 correspond to original claims 7-11, respectively. New claim 38 draws support from original claim 14, and also from the specification at page 9 line 21 to page 10 line 1.

Based at least on the foregoing indications of support in the specification, the drawing figures, and the claims originally filed, it is respectfully submitted that the new claims are believed to introduce no new matter.

Substantive Issues - Section 103

The Official Action rejected claims 1-20, 22-25 and 28 under 35 USC 103(a) as being unpatentable over Su (US Pub. 2002/0026380; "SU") in view of Keech (US Pub. 2002/0029342; "KEECH").

The Official Action rejected claim 21 under 35 USC 103(a) as being unpatentable over SU in view of KEECH, and further in view of Suila et al. (US Pub. 2002/0194303; "SUILA").

In response, it is firstly noted that claims 1-28 are canceled.

It is respectfully submitted that new claims 29-52 are patentable over SU, KEECH, and SUILA, individually or in combination, at least because none of SU, KEECH, or SUILA, individually or in combination, teach or suggest all the features recited by the claims.

For example, it is respectfully submitted that none of SU, KEECH, and SUILA, individually or in combination, teach or suggest a step of sending from a cellular radiotelephone to a radiotelephony message managing device of a service center of an issuing institution, one radiotelephony message comprising a commercial site identification code, the amount of money, and at least one identification data, the identification data being any of instrument identification data, user identification data and telephone identification data, as recited in new claim 29.

It is further respectfully submitted that none of the references applied by the Official Action, individually or in combination, teach or suggest the sending of one radiotelephony message as recited in claim 29 as an SMS and/or MMS message.

On the contrary, SU fails at least to disclose any teaching or suggestion of the use of SMS or MMS messaging, and KEECH fails at least to teach a radiotelephony message from a user's cellular radio telephone including a commercial site identification code and an amount of money to be transacted and an identification data as recited by claim 29.

The Official Action offers SU as teaching the inputting of credit card information for storage on a server (paragraph [0049]), but concedes that SU fails to teach an issuing institution sending a confirmation or refusal of authorization of a mandate of payment (SU discloses an E-commerce Shopping Server verifying payment, but fails to disclose how; see paragraph [0104]), and fails to teach the sending step from a user's telephone to a radiotelephony message managing device of a service center of an issuing institution for issuing a credit instrument.

The Official Action offers KEECH as teaching transmission of a volatile identification code to an electronic computer by way of a specific electronic communication device for the purpose of rendering a positive identification.

However, it is respectfully submitted that even if one of skill would have modified SU with KEECH as suggested by the Official Action, the combination fails to yield all the features of the invention as recited in the claims, particularly independent claim 29. At best, the modification would only yield an electronic shopping center in accordance with SU, but with a modified electronic payment system such that the shopper, in using a credit card in the traditional way, would also be required to receive and correctly answer an identity challenge via her mobile phone before the vendor receives approval to complete the transaction. This is not what is claimed.

At this point, a review of the references is helpful.

Overview of the Applied References: Su

The primary reference, SU, teaches an electronic shopping mall offering a shopper a choice between the traditional brick-and-mortar experience of browsing within an actual shopping space or using a computer kiosk connected to a common computer system, the computer system tying together inventory, sales, and delivery for each of the vendors participating in the shopping mall (see paragraphs [0012]-[0021]).

SU, however, makes no teaching with respect to financial transactions of any kind.

On the contrary, SU expressly discloses that an E-commerce Shopping Server (ESS) would incorporate "existing commercial payment systems and softwares... in payment handling," (paragraph [0100]). Even in the web-based embodiment, "One skilled in the art would appreciate that existing commercial payment systems and softwares may be used here in payment handling without modification," (paragraph [0104]).

The only teaching remotely relevant to the use of payment transactions offered by SU is that shoppers are recommended (but not required) to have a "membership account" stored on the ESS to track their transactions and receive "expedited service," (paragraph [0049]). This information may include credit card information. But there is no disclosure of the use of this credit card information in any form of

transaction, other than the actual storage of the credit card information into the ESS database.

Hence, SU is explicit in that it makes no new teaching to transaction processing, expressly relying upon "existing commercial payment systems and softwares" to perform this function.

It is also noted that SU teaches "The store operator 47 upon the request of the shopper 8 may input the shopper's information through a SMS 45," (paragraph [0049]). This teaching of an SMS has nothing at all in common with Short Message Service or SMS for exchange of short text messages between mobile phone devices. According to SU, "SMS" stands for Store Management System, and is not at all associated with a mobile phone communications protocol (paragraph [0040]; see also element 45 in Figure 1).

#### Overview of the Applied References: Keech

KEECH is directed to an electronic authentication method for verifying a user's identity. In KEECH, a user of a mobile device such as a mobile phone is given a "permanent ID", (paragraphs [0010], [0012]-[0013]) and also a "mask code" (paragraphs [0016], [0018]) which is known only to the user (or stored on the mobile phone) and the authenticating server.

In the course of a financial transaction such as the use of a credit card, the transaction is initiated by the vendor swiping the credit card, whereupon the authenticating server

sends an SMS message to the user's mobile device including a computer-generated pseudo-random string (paragraph [0025]). The user responds to this SMS message with a volatile identifier, computed from a combination of the pseudo-random string and the mask known to the user, and provides this volatile identifier to the retailer (paragraph [0025]). The retailer then transmits the volatile identifier to the authenticating server.

If the volatile identifier is correctly authenticated by the authenticating server, then a message is transmitted to the vendor to approve the transaction (paragraph [0025]). The KEECH reference thus teaches an authentication system taking advantage of the unique telephone number assigned to the user's mobile phone and at least one memorized code (the "mask") in order to verify a financial transaction initiated by a vendor.

In each of the steps of the transaction, KEECH teaches that communication with the authenticating server or a financial clearing house is initiated only by the vendor. Even in the internet-based embodiment, the user's electronic device communicates with a computer server "operated by an Internet retailer," wherein the user submits an account number to the server "through the retailer's website," (paragraph [0029]).

An SMS message containing the pseudo-random string is then transmitted to the person's mobile telephone, and the person then causes a volatile identification code to be generated and then submitted to the retailer's server from where it is transmitted to the main computer for verification before the transaction is authorized and funds released.

Paragraph [0029]; emphasis added.

The only teachings where a user initiates communication with the authenticating server is i) to issue a lock code such as when the device is stolen (paragraph [0027]), or ii) to respond to a final transaction confirmation message issued upon receiving the proper volatile identification code from the vendor (paragraph [0028]).

Overview of the Applied References: Suila et al.

SUILA is directed to a system for retrieving consumer product and service information (Abstract) that may use International Mobile Equipment Identity (IMEI) information of mobile phones to track requests and content to a particular mobile phone (paragraph [0075]).

The Invention Recited by the Claims is Non-Obvious

It is respectfully submitted that the references applied by the Official Action fail to teach all the features recited by the claims.

On page 6, the Official Action offers paragraph [0010] of KEECH as teaching the step of sending from a user's telephone to a radiotelephony message managing device of a service center of the issuing institution a radiotelephony message comprising a commercial site identification code, the amount of money and/or instrument identification data and/or user identification data and/or telephone identification data, the commercial site



identification code and the amount of money being inputted by the user during composition of the message.

Applicant respectfully disagrees. The “electronic communications device” described by KEECH paragraphs [0010] and [0018] engages only in the identity authentication information, wherein the only financial transaction information transmitted is the credit card number in the embodiment described in paragraph [0025] (wherein the “electronic communications device” is expressly disclosed as a EFTPOS, not a mobile phone, and transaction information is expressly carried out via modem link, not SMS).

In the middle paragraph of page 3, the Official Action contends that paragraph [0049] of SU teaches interaction between the customer and the service provider.

On the contrary, as indicated above, this disclosure concerns a local storage of information with the ESS of the shopping mall. There is no disclosure of any transmission of this information with an issuing institution, or even an authentication service as taught by KEECH.

In the paragraph spanning pages 3-4, the Official Action contends that paragraph [0090] and Figure 3 of KEECH teach a direct contact with the card holder. This disclosure of KEECH details an embodiment of using the Internet as described above and paragraph [0029]. Particularly, the user’s browser contacts an authenticating server and is prompted to provide a user ID,

credit or debit card number. If the user ID is found, then an applet is initiated for the purpose of processing the pseudo-random string and the mask (referred to in paragraph [0090] as a "TAC" code; see paragraph [0079]).

However, as illustrated by Figure 4, it is clear that communication is not conducted between the user's browser and the issuing institution. KEECH expressly discloses these steps to distinguish and separate transmission of the user name and the TAC so that the vendor's web site avoids the TAC. As illustrated in Figure 4, all routes pass through the merchant's applet, and upon successful authentication and authorization, an "accept" notice is sent along path 436 to the merchant site 405, and only then relayed to the user device 403 (paragraph [0093]).

Hence, there is no teaching here of a direct contact between an issuing institution with the card holder.

There is further no teaching in this embodiment of a communication between a user's mobile device and an issuing institution over a messaging protocol such as SMS, as KEECH's teaching in paragraphs [0087]-[0093] are expressly disclosed as being over the internet.

Moreover, there is no teaching or suggestion in any of the references of a step of transmitting a commercial site identification code from the user's telephone to a radiotelephony message managing device of a service center, as required by claim

29, and particularly no teaching of such a transmission over SMS and/or MMS.

A commercial site identification code is irrelevant to the purpose of identity verification taught by KEECH. KEECH consistently teaches that a transaction is always initiated by the vendor or commercial site. Unlike the present invention, KEECH is not concerned with the particulars of transaction (e.g., who is to receive funds and how much); KEECH is only concerned with identity verification by way of the secret mask or TAC known only by the user and the card issuer.

In contrast, the present invention allows an owner of a credit instrument to carry out all the transactions necessary to authorize payment to a vendor without having to pass sensitive information about the credit instrument, particularly the credit instrument itself, to the commercial site (see, e.g. page 7, lines 13-17). None of SU, KEECH, or SUILA teach or suggest anything similar to this.

It is therefore respectfully submitted that none of the references SU, KEECH, or SUILA teach or suggest all the features recited by independent claim 29. Hence, even if one of skill were to combine the references as alleged by the Official Action, the result fails to yield the invention as claimed.

It is therefore respectfully submitted that independent claim 29 is patentable over the references applied by the Official Action.

It is also respectfully submitted that claims depending from claim 29 are patentable at least for depending from a patentable parent claim.

It is further respectfully submitted that new claims 51 and 52 are patentable at least for the reasons set forth above as to claim 29 and claims depending therefrom.

Reconsideration and allowance of the claims are respectfully requested.

From the foregoing, it will be apparent that Applicant has fully responded to the October 29, 2009 Official Action and that the claims as presented are patentable. In view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, the Examiner is invited to telephone the attorney for Applicant at the number provided below if the Examiner is of the opinion that further discussion of this case would be helpful in advancing prosecution.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

/Jeremy G. Mereness/  
Jeremy G. Mereness, Reg. No. 63,422  
209 Madison Street  
Suite 500  
Alexandria, VA 22314  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

JGM/fb